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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/204,238 12/03/98 HAMILTON

G AR138-X

EXAMINER

HM12/1019

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SIXTH FLOOR
WASHINGTON DC 20005

CHANG, C

ART UNIT

PAPER NUMBER

1612

DATE MAILED:

10/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/204,238

Applicant(s)

Hamilton et al.

Examiner

Celia Chang

Group Art Unit

1612



☒ Responsive to communication(s) filed on Oct 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-71 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-71 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 5, drawn to pyrrolidinyl compounds (n=1), classified in class 548, subclass various depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 1-4, 6-11 reading on the elected compounds can be prosecuted together with the compounds to the extent of the election. Claims 14-25, upon election of a single disclosed pathology/disease treatable with the method, can be prosecuted with the elected compounds to the extent of the election.
- II. Claims 12-13, and 26-27, drawn to composition and method of treating neurological disorder using the combination composition, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single combination of ingredients and a single pathology/disease treatable by the combination is also required.
- III. Claims 28-34, drawn to method of stimulate peripheral nerve growth, classified in class various, subclass various. If this group is elected, a further election of a single disclosed compound for the method is also required.
- IV.. Claims 35-36, drawn to method of stimulate peripheral nerve growth by combination of active ingredients, classified in class various, subclass various. If

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this group is elected, a further election of a single disclosed combination of active ingredients for the method is also required.

- V. Claims 37-43, drawn to method of neuro-regeneration, classified in class various, subclass various. If this group is elected, a further election of a single disclosed compound for the method is also required.
- VI. Claims 44-45, drawn to method of neuro-regeneration, classified in class various, subclass various. If this group is elected, a further election of a single disclosed combination for the method is also required.
- VII. Claims 46-55, drawn to method of preventing neurodegeneration, classified in class various, subclass various. If this group is elected, a further election of a single disclosed compound for the method is also required.
- VIII. Claims 56-57, drawn to method of preventing neurodegeneration, classified in class various, subclass various. If this group is elected, a further election of a single disclosed combination for the method is also required.
- IX. Claims 58-64, drawn to composition and method of treating alopecia, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed compound for the method is also required.
- X. Claims 1-4, 6-11, 14-25, remaining compounds and methods or composition claims 65-71, further restriction is required.

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The inventions are distinct, each from the other because:

The compounds differ in elements, bonding arrangement and chemical properties to such an extent that a reference anticipating compounds of one group would not necessarily imply unpatentability of another in the same claim. The methods are distinct and independent in end condition being treatable as well as the active ingredients or combination of active ingredients being employed. The search for each independent invention is not co-extensive and separate examination must be performed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

A facsimilia copy of this restriction was sent to Mr. Niebylski on Aug. 9, 1999 to request an election to the above restriction requirement, but did not result in an election being made.


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

CCC/Chang

Oct. 15, 1999


CEILA CHANG
PRIMARY EXAMINER
GROUP 1200 (b) 2